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EXAMINER

SKAARUP, JASON M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3714

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,555

Applicant(s)

ROBB, ARTHUR S.

Examiner

Jason Skaarup

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/08/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The Examiner considered the Information Disclosure Statement (IDS) submitted on March 8, 2004.

Claim Objections

2. Claims 14 and 18 are objected to because of the following informalities:

Claims 14 and 18 recite the limitation "the display unit" in lines 12 and 10, respectively. There is insufficient antecedent basis for the limitation "the display unit" in claims 14 and 18. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Caro et al. (U.S. Patent Application Publication 2003/0050109).

Caro et al. disclose a method of conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof). The disclosed method comprises:

- receiving a base wagering game entry and a base wagering game wager from a player (paragraphs [0042], [0043]);

- receiving an instant win game wager from the player (paragraphs [0041] and [0045]);

- storing a game theme indicator (paragraphs [0041], [0045], [0046] and [0056] wherein memory 22 stores a theme indicator in the form of the type or name of the instant win game selected by the player);

- storing a plurality of instant win game outcome display themes (paragraphs [0041], [0045] and [0046] wherein memory 22 stores a plurality of instant win game outcome display themes, e.g., Pick 3 and Pick 4, detailed in Figures 3A and 3B along with the related description thereof);

- determining an outcome of the instant win game for the player (paragraph [0049]);

- displaying the outcome of the instant win game to the player, the outcome being displayed with one of the plurality of instant win game outcome display themes wherein the one of the plurality of instant win game outcome display themes corresponds to the stored game theme indicator (paragraph [0049] and Figures 3A and 3B along with the related description thereof); and

awarding the player an instant win game prize corresponding to the outcome of the instant win game (paragraph [0049] and Figures 3A and 3B along with the related description thereof).

Regarding claim 2, Caro et al. disclose that the instant win game and base wagering game are implemented in a gaming system having a host computer (computer 20) communicatively linked to a plurality of terminal units (terminals 16) and that the method further comprises receiving the base wagering game entry, the base wagering game wager and the instant win game wager at one of the terminal units (terminals 16). See Figure 1 along with the related description thereof and paragraph [0040].

Regarding claim 3, Caro et al. disclose determining the outcome of the instant win game for the player at one of the host computer (computer 20) and terminal units (terminals 16) receiving the base wagering game entry, the base wagering game wager and the instant win game wager (paragraph [0049] wherein the computer 20 calculates matches and records results and prizes associated with each ticket 12).

Regarding claim 4, Caro et al. disclose displaying the outcome of the instant win game to the player at one of the terminal units (terminals 16) receiving the base wagering game entry, the base wagering game wager and the instant win game wager (paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes).

Regarding claim 5, Caro et al. disclose that each terminal unit (terminal 16) includes a ticket printer (paragraph [0040], wherein the terminal 16 print tickets 12) and that the method further comprises printing a ticket (ticket 12) at the printer of one of the

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terminal units (terminals 16), wherein the ticket includes first indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof) and second indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof).

Regarding claim 6, Caro et al. disclose that each terminal unit (terminal 16) includes a video display device (paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (terminals 16), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof).

Regarding claim 7, Caro et al. disclose that the instant win game and base wagering game are implemented in a gaming system having a host computer (computer 20) communicatively linked to a plurality of terminal units (terminals 16) and that the method further comprises storing the game theme indicator at one of the host computer (computer 20) and the terminal units (terminals 16). See paragraphs [0041], [0045] and [0046] and Figure 1 along with the related description thereof, wherein computer 20 includes memory 22 which stores a theme indicator in the form of the type or name of the instant win game selected by the player and stores a plurality of instant win game

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outcome display themes, e.g., Pick 3 and Pick 4, detailed in Figures 3A and 3B along with the related description thereof.

Regarding claim 8, Caro et al. disclose that the instant win game and base wagering game are implemented in a gaming system having a host computer (computer 20) communicatively linked to a plurality of terminal units (terminals 16) and that the method further comprises storing the plurality of instant win game outcome display themes at the terminal units (terminals 16). See paragraph [0040] wherein terminal 16 is a point-of-sale terminal or a computer. Computers inherently include a processor and a data storage device or memory. The instant win game outcome display themes, e.g., Pick 3 or Pick 4 of Figures 3A and 3B, are communicated from the computer 20 to the terminal 16 (paragraph [0020]) and at least temporarily stored in a memory of the terminal 16 and processed by a processor of the terminal 16 prior to display or printing for the player.

Regarding claim 10, Caro et al. disclose that the instant win game and base wagering game are implemented in a gaming system having a host computer (computer 20) communicatively linked to a plurality of terminal units (terminals 16) and that the method further comprises receiving the base wagering game entry, the base wagering game wager and the instant win game wager at the input device of the terminal (paragraphs [0020] and [0040] wherein player selections made at the terminal 16 are transmitted to the computer 20).

Regarding claim 11, Caro et al. disclose that each terminal unit (terminal 16) includes a ticket printer (paragraph [0040], wherein the terminal 16 print tickets 12) and

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that the method further comprises printing a ticket (ticket 12) at the printer of one of the terminal units (terminals 16), wherein the ticket includes first indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof) and second indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof).

Regarding claim 12, Caro et al. disclose that each terminal unit (terminal 16) includes a video display device (paragraphs [0040] and [0074] wherein each terminal 16 includes a video display to display game tickets and outcomes) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (terminals 16), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 9 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penrice (U.S. Patent Application Publication 2004/0266514) in view of Caro et al.

Penrice teaches a gaming system having a plurality of terminal units (gaming units 20) and a host computer (network computer 22, 32) operatively coupled to the terminal units (Figure 1 along with the related description thereof) over a network 40 to effect play of a lottery game. Penrice teaches that different lottery games can be provided by the gaming system (paragraphs [0058]), which could include those of different themes. However, Penrice does not explicitly teach providing a lottery game that includes a base game and an instant win game. In a related gaming system, Caro et al. teach a lottery game employed over a network for effecting play of a lottery game having a base game and an instant win game. Caro et al. teaches a lottery game having a base game and an instant win game increases player interest in the game by allowing players to select numbers as in a draw lottery while also receiving immediate results as in an instant win game (paragraphs [0009], [0010] and [0011]). It would have been obvious to incorporate the lottery game as taught by Caro et al. into the gaming system as taught by Penrice in order to increase player interest in the game of Penrice by providing a lottery game having a base game and an instant win game as desirably taught by Caro et al. in paragraphs [0009], [0010] and [0011]). Thus, the combination of Penrice and Caro et al. teach a game system for conducting an instant win game in combination with a base wagering game over a network, wherein the computer 22, 32 of Penrice would be programmed to perform the functions of host computer 20 of Caro

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et al. and wherein the gaming units 20 of Penrice would be programmed to perform the functions of the terminal units 16 of Caro et al.

Regarding claim 14, the combination of Penrice and Caro et al. teach a game system for conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof in Penrice). The disclosed game system comprises:

a plurality of terminal units (gaming units 20) and a host computer (computer 22, 32), including a memory (memory 22d) and a controller (MP 22c), operatively coupled to the terminal units (gaming units 20). Each terminal unit (gaming unit 20) comprises:

an input device that allows a player to make a plurality of input selections (control panel 66 of Figure 3 along with the related description thereof);

a terminal unit memory device (memory 106 of Figure 3 along with the related description thereof);

a currency accepting mechanism that is capable of allowing the player to deposit a medium of currency (coin acceptor 52 and bill acceptor 54 of Figure 3 along with the related description thereof);

a value-dispensing mechanism that is capable of dispensing value to the player (step 262 of Figure 4 and step 318 of Figure 5 along with the related descriptions thereof wherein controller 100 in gaming unit 20 dispenses value to the player based on the game outcome);

an output device (ticket printer 56, display 70 and speaker 62 of Figure 3 along with the related description thereof); and

a terminal controller (MP 104 of Figure 3 along with the related description thereof) operatively coupled to the display unit, the input device, the terminal unit memory device, the currency accepting mechanism, the value-dispensing mechanism, and the output device,

wherein the terminal unit controller (MP 104) is programmed to allow a player to enter a base wagering game entry at the input device (step 554 of Figure 9 along with the related description thereof) and to allow a player to make a base wagering game wager and an instant win game wager at the currency accepting mechanism (paragraphs [0042] and [0045] of Caro et al. wherein a player can place separate wagers for the base game and the instant win game),

wherein the terminal unit controller (MP 104) is programmed to store a game theme indicator at a corresponding terminal unit (gaming unit 20),

wherein the terminal unit controller (MP 104) is programmed to store a plurality of instant win game outcome display themes at the terminal unit memory device (memory 106),

wherein the terminal unit controller (MP 104) is programmed to determine the outcome of the instant win game,

wherein the terminal unit controller (MP 104) is programmed to display the outcome of the instant win game at the output device (display 70) with the outcome being displayed with one of the plurality of instant win game outcome display themes corresponding to the game theme indicator, and

wherein the terminal unit controller (MP 104) is programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

Regarding claim 15, the combination of Penrice and Caro et al. teach that each terminal unit (gaming unit 20) includes a ticket printer (printer 56) and that the method further comprises printing a ticket (ticket 12 of Caro as shown in Figures 3A and 3B along with the related description thereof) at the printer (printer 56) of one of the terminal units (gaming units 20), wherein the ticket includes first indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof in Caro et al.) and second indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof in Caro et al.).

Regarding claim 16, the combination of Penrice and Caro et al. teach that each terminal unit (gaming unit 20) includes a video display device (display 70) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (gaming units 20), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof describe tickets 12 in Caro et al. that would be displayed on display 70 in the gaming system taught by Penrice).

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Regarding claim 17, the combination of Penrice and Caro et al. teach that the host computer controller (MP 22c) determines the outcome of the instant win game and stores the game theme indicator at the memory (memory 22d) and wherein the terminal controller (MP 104) stores a plurality of instant win game outcome themes at the terminal memory (memory 106) and transmits the outcome of the instant win game and the game theme indicator to the terminal unit (gaming unit 20).

Regarding claims 9 and 13, the combination of Penrice and Caro et al. teach a game system including dispensing the instant win game prize to the player via a value dispensing unit (step 262 of Figure 4 and step 318 of Figure 5 along with the related descriptions thereof wherein controller 100 in gaming unit 20 dispenses value to the player based on the game outcome) at the terminal (gaming unit 20). Penrice in combination with Caro et al. teaches dispensing value to the player, as taught by Penrice, based on the instant win game outcome taught by Caro et al.

Regarding claim 18, the combination of Penrice and Caro et al. teach a terminal unit (gaming unit 20) for conducting an instant win game in combination with a base wagering game (Figure 1 along with the related description thereof in Penrice). The disclosed terminal unit (gaming unit 20) comprises:

an input device that allows a player to make a plurality of input selections (control panel 66 of Figure 3 along with the related description thereof);

a terminal unit memory device (memory 106 of Figure 3 along with the related description thereof;

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a currency accepting mechanism that is capable of allowing the player to deposit a medium of currency (coin acceptor 52 and bill acceptor 54 of Figure 3 along with the related description thereof);

a value-dispensing mechanism that is capable of dispensing value to the player (step 262 of Figure 4 and step 318 of Figure 5 along with the related descriptions thereof wherein controller 100 in gaming unit 20 dispenses value to the player based on the game outcome);

an output device (ticket printer 56, display 70 and speaker 62 of Figure 3 along with the related description thereof); and

a controller (MP 104 of Figure 3 along with the related description thereof) operatively coupled to a display unit, the input device, the terminal unit memory device, the currency accepting mechanism, the value-dispensing mechanism, and the output device,

wherein the controller (MP 104) is programmed to allow a player to enter a base wagering game entry at the input device (step 554 of Figure 9 along with the related description thereof) and to allow a player to make a base wagering game wager and an instant win game wager at the currency accepting mechanism (paragraphs [0042] and [0045] of Caro et al. wherein a player can place separate wagers for the base game and the instant win game),

wherein the controller (MP 104) is programmed to store a game theme indicator at a corresponding terminal unit (gaming unit 20),

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wherein the controller (MP 104) is programmed to store a plurality of instant win game outcome display themes at the terminal unit memory device (memory 106),

wherein the controller (MP 104) is programmed to determine the outcome of the instant win game,

wherein the controller (MP 104) is programmed to display the outcome of the instant win game at the output device (display 70) with the outcome being displayed with one of the plurality of instant win game outcome display themes corresponding to the game theme indicator, and

wherein the controller (MP 104) is programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

Regarding claim 19, the combination of Penrice and Caro et al. teach that each terminal unit (gaming unit 20) includes a ticket printer (printer 56) and that the method further comprises printing a ticket (ticket 12 of Caro as shown in Figures 3A and 3B along with the related description thereof) at the printer (printer 56) of one of the terminal units (gaming units 20), wherein the ticket includes first indicia corresponding to the base wagering game entry and base wagering game wager (indicia 26-3A and Figures 3A and 3B along with the related description thereof in Caro et al.) and second indicia corresponding to the outcome of the instant win game with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A and 3B along with the related description thereof in Caro et al.).

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Regarding claim 20, the combination of Penrice and Caro et al. teach that each terminal unit (gaming unit 20) includes a video display device (display 70) and that the method further comprises displaying the outcome of the instant win game at the video display device of one of the terminal units (gaming units 20), the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the stored game theme indicator (Figures 3A, 3B along with the related description thereof describe tickets 12 in Caro et al. that would be displayed on display 70 in the gaming system taught by Penrice).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited (PTO-892).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jason Skaarup whose telephone number is 571-272-4455. The Examiner can normally be reached on Monday-Thursday (10:00-8:00).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Primary, Jessica Harrison can be reached at 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line extending to the right.

JESSICA HARRISON
PRIMARY EXAMINER